

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed October 19, 2009. At the time of the Office Action, Claims 1-43 were pending in the Application and stand rejected. Applicant amends the Independent Claims without prejudice or disclaimer. The amendments to these claims are not the result of any Prior Art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Claim Objections and Corrections

The Examiner objected to Claims 39 and 43 because of suggested informalities. Applicant has amended Claim 39 to address the Examiner's concern and Claim 43 has been cancelled.

In Applicant's Request for Continued Examination, filed on August 4, 2009, the clause, "conditionally sending, based on the one or more service-conditions, the service-initiation request from a client to a server over a network" was inadvertently omitted from the Amended Independent Claim 17. Applicant has included the clause in the currently Amended Independent Claim 17, with strikethrough to indicate it should be removed from the claim.

Section 101 Rejection

The Examiner rejects Claims 1-43 under 35 U.S.C. §101 and stated that the claimed invention is directed to non-statutory subject matter. The Examiner further rejects claims 1-28 under 35 U.S.C. §101 as not falling within one of the four statutory categories of the invention. Applicant has made a modest amendment to the identified Independent Claims in an effort to address the Examiner's concern and to comply with the changing §101 guidelines at the USPTO.

Any amendment in this regard should not be construed as an agreement with, or acquiescence to, the propriety of the Examiner's contention. Applicant reserves the right to comment on the appropriateness of the §101-based amendment at a future time, should Applicant deem it appropriate to do so. Applicant respectfully submits that all of the pending claims have been shown to overcome the Examiner's §101 rejection.

Section 102 Rejection

The Examiner rejects Claims 1-3, 5-11, 13-19, 21-27, 29-31, 33, 36-38, 40 and 43 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,699,513 issued to Feigen et al. (hereinafter "*Feigen*"). The Examiner further rejects Claims 1-2, 5-13, 15, 17-18, 21-22, 25, 27, 29-30, 33-37 and 40-43 as being anticipated by U.S. Patent No. 5,560,008 issued to Johnson et al. (hereinafter "*Johnson*"). The Independent Claims have been amended and are respectfully submitted as being allowable over *Feigen* and *Johnson*.

Independent Claims 1 and 29 are Allowable over Feigen and Johnson

Applicant respectfully submits that a claim is anticipated only if each element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide "a

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”⁴

Independent Claim 1, as amended, recites intercepting a connection request “...*within the network...*” where the connection request is initiated from a client within the network to establish a communication conduit between the client and a server “...*in order to access a specific service on the server...*” Amended Independent Claim 1 also recites identifying “...*the communication conduit corresponding to the client, the server, and the specific service...*” and identifying “...*one or more usage conditions associated with the communication conduit, wherein the one or more usage conditions are defined to permit conditional use of the communication conduit by the client...*”

No reference discloses a method of intercepting a connection request within a network, when the connection request is initiated from a client within the network, to permit conditional use of a communication conduit by the client. First, the references cited by the Examiner do not teach intercepting connection requests from a client within the network having the client. Second, nothing in *Feigen* or *Johnson* teaches usage conditions that are associated with the communication conduit and that are defined to permit conditional use of the communication conduit by the client, where the communication conduit corresponds to the client, the server, and the specific service on the server. Although the Examiner asserts that *Feigen* authorizes a client to server connection, no reference of record, including *Feigen*, teaches usage conditions that are associated with the communication conduit and that are defined to permit conditional use of the communication conduit by the client. No reference of record includes these elements as provided in Independent Claim 1. Applicant has reviewed the cited references in their respective entireties and finds nothing that would be relevant to these limitations.

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

Independent Claim 29 recites limitations similar, but not identical, to these limitations and, therefore, is allowable using a similar rationale. Additionally, the corresponding dependent claims from Independent Claims 1 and 29 are also patentably distinct for analogous reasons.

Independent Claims 17 and 36 are Allowable over Feigen and Johnson

Independent Claim 17, as amended, recites intercepting a service-initiation request “...*within the network...*” where the service-initiation request is initiated from a client within the network “...*in order to access a specific service on a server....*” Amended Independent Claim 17 also recites identifying “...*a request-type corresponding to the service-initiation request and the specific service...*” and identifying “...*one or more service conditions associated with the request-type, wherein the one or more service conditions are defined to permit conditional use of the request-type by the client....*”

No reference discloses a method of intercepting a service-initiation request within a network, when the service-initiation request is initiated from a client within the network, to permit the client to have conditional use of the request-type corresponding to the service-initiation request and the specific service the client is attempting to access. First, the references cited by the Examiner do not teach intercepting service-initiation requests from a client within the network having the client. Second, nothing in *Feigen* or *Johnson* teaches service conditions associated with a request-type to permit conditional use of the request-type by the client, where the request-type corresponds to the service-initiation request and the specific service on the server. No reference of record teaches these limitations, which are provided in Independent Claim 17. Applicant has reviewed the cited references in their respective entireties and finds nothing that would be relevant to these limitations.

Independent Claim 36 recites limitations similar, but not identical, to the limitations in Claim 17 and, therefore, is allowable using a similar rationale. Additionally, the corresponding

dependent claims from Independent Claims 17 and 36 are also patentably distinct for analogous reasons.

Section 103 Rejection

The Examiner rejects Claims 4, 20, 32 and 39 under 35 U.S.C. §103(a) as being unpatentable over *Feigen* in view of U.S. Publication No. 2003/0120811 issued to Hanson et al. (hereinafter "*Hanson*"). The Examiner further rejects various Claims under 35 U.S.C. §103(a) as being unpatentable over several references, including U.S. Patent No. 6,587,877 issued to Dougliis et al. (hereinafter "*Dougliis*"), U.S. Patent No. 6,442,686 issued to McArdle et al. (hereinafter "*McArdle*") and U.S. Patent No. 7,152,104 issued to Musante et al. (hereinafter "*Musante*").

Applicant respectfully reminds the Examiner that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.⁵

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each claim limitation of the Independent Claims. This has been evaluated at length in the §102 analysis provided above.

For at least these reasons, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

⁵ See M.P.E.P. §2142-43.

CONCLUSION

Applicant has now made a sincere attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

An Information Disclosure Statement is being filed simultaneously herewith. The Information Disclosure Statement late submission fee of \$1.17(p) in the amount of \$180 is being paid concurrently herewith via the Electronic Filing System (EFS) by way of Deposit Account No. 50-4889 authorization. No additional fees are believed due. However, please apply any other charges or credit any overpayment to Deposit Account No. 50-4889 of PATENT CAPITAL GROUP, referencing the attorney docket number referenced above.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact Leslie E. Dalglish at 972-979-5890.

Respectfully submitted,

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